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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77850772
Applicant	Poly-Gel L.L.C.
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Date	01/24/2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

***In re Application of*: POLY-GEL L.L.C.**

SERIAL NO.: 77/850,772

FILED: OCTOBER 16, 2009

MARK: ARCTIC HEAT

INTERNATIONAL CLASS: 10

TRADEMARK ATTORNEY: CHARISMA HAMPTON/LAW OFFICE 112

APPEAL BRIEF

Hon. Commissioner for Trademarks
United States Patent and Trademark Office
P. O. Box 1451
Alexandria, Virginia 22313-1451

To the Trademark Trial and Appeal Board:

I. Introduction

On January 19, 2011, Applicant, Poly-Gel, L.L.C., Appellant herein, timely filed a *Notice of Appeal* from the final refusal-to-register, dated July 19, 2010, in which the Examining Attorney refused registration of Appellant's trademark in International Class 10, pursuant to §2(d) of the Trademark Act, 15 U.S.C. §1052(d). Appellant now respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's decision not to pass Appellant's trademark to publication.

II. Appellant's Mark

Appellant's trademark is the word mark "ARCTIC HEAT." The mark consists of "standard characters" without claim to any particular font, style, size or color. Appellant seeks registration of his mark on the Principal Register for the goods recited as "[t]herapeutic hot and cold compression wraps for cooling or warming parts of the human body; shoulder supports, ankle supports, back supports, knee supports, wrist supports, elbow supports and orthopedic supports with compression and without compression for reducing pain and increasing circulation and mobility to areas of the human body to which the supports are applied," in International Class 10.

Appellant has entered a disclaimer to the word "HEAT" apart from the mark, as shown.

III. The Refusal-to-Register and Pertinent Facts

Appellant filed an "intent-to-use" trademark application on October 16, 2009, to register the word mark "ARCTIC HEAT" on the Principal Register in International Class 10.

On December 23, 2009, the Examining Attorney issued a first Office Action refusing registration, pursuant to §2(d) of the Trademark Act, on the contention that a likelihood-of-confusion would exist between Appellant's mark and the mark of U.S. Trademark Registration No. 2,944,243 for the design mark incorporating the wording "ARCTICHEAT. COOL DOWN AND FIRE UP" for goods recited as "human and

veterinary medical devices, namely cooling and heating rehabilitation packs; temperature regulating devices for medical purposes, namely cooling and heating jackets and vests" and "food and beverage insulating drink coolers, holders and containers for bottles and cans." The Examining Attorney also objected to Appellant's original recitation of goods as being indefinite and required a disclaimer of the term "HEAT."

A substantive reply to the §2(d) likelihood-of-confusion refusal-to-register of the first Office Action, along with an amendment to the recitation of goods and the entry of the required disclaimer, was timely filed June 23, 2010.

On July 19, 2010, the Examining Attorney issued a second, and "final," Office Action maintaining the §2(d) likelihood-of-confusion refusal-to-register, as issued in the first Office Action. The Examiner Attorney withdrew the indefiniteness objection to the recitation of goods issued as part of the first Office Action and acknowledged Appellant's disclaimer of the word "HEAT." Appellant's recitation of goods is currently as recited in the preceding section of this *Appeal Brief.*

Accordingly, there are no issues presented to the Board for resolution other than the disagreement between Appellant and the Examining Attorney regarding the correctness of the issued §2(d) likelihood-of-confusion refusal-to-register.

IV. Issue

The single issue for resolution on this Appeal is as follows:

Does a likelihood of confusion exist between Appellant's trademark "ARCTIC HEAT," for "[t]herapeutic hot and cold compression wraps for cooling or warming parts of the human body; shoulder supports, ankle supports, back supports, knee supports, wrist supports, elbow supports and orthopedic supports with compression and without compression for reducing pain and increasing circulation and mobility to areas of the human body to which the supports are applied," and the mark of the applied registration "ARCTICHEAT. COOL DOWN AND FIRE UP" for goods recited as "human and veterinary medical devices, namely cooling and heating rehabilitation packs; temperature regulating devices for medical purposes, namely cooling and heating jackets and vests" and "food and beverage insulating drink coolers, holders and containers for bottles and cans?"

V. Argument

No Likelihood of Confusion Exists Between Appellant's Trademark "ARCTIC HEAT" and the Design Mark of the Applied Registration "ARCTICHEAT. COOL DOWN AND FIRE UP" in View of the Narrow Scopes of Protection to Which the Respective Trademarks are Entitled

In the final Office Action, dated July 19, 2010, the Examining Attorney has refused registration of Appellant's trademark, "ARCTIC HEAT," pursuant to §2(d) of the Trademark Act, on the contention that a likelihood-of-confusion would exist between Appellant's mark and the trademark of U.S. Trademark Registration No. 2,944,243 for the design mark incorporating the wording "ARCTICHEAT. COOL DOWN AND FIRE UP," for goods recited as "human and veterinary medical devices, namely cooling and heating rehabilitation packs; temperature regulating devices for medical purposes, namely cooling and heating jackets and vests" and "food and beverage insulating drink coolers,

holders and containers for bottles and cans." Appellant's goods, by contrast, are "therapeutic hot and cold compression wraps" for the human body and "supports" for various parts of the human body for "increasing circulation and mobility to areas of the human body to which the supports are applied."

In reply to the overall merits of the Examining Attorney's §2(d) likelihood-of-confusion refusal-to-register, Appellant respectfully submits that the prefix "ARCTIC" and "HEAT" are quite common terms used by many entities in numerous industries to signify coolness and warmth. *See, e.g.*, *In re Nantucket, Inc.*, 677 F.2d 95, 107 *n.* 8, 213 USPQ 889, 893-894 *n.* 8 (C.C.P.A. 1982) (speculating that "ARCTIC" may be a useful trademark for marketing refrigerators, implicitly because of the cold conditions associated with the Arctic region). The mark of the applied registration and Appellant's trademark both use "ARCTIC" and "HEAT" for creating associations of cold and hot conditions resulting from the relevant respective goods of the owner of the cited registration and Appellant's goods. As such, terms such as "ARCTIC" and "HEAT" should be viewed as quite weak when intended to signify coolness and warmth and, consequently, not entitled to the same scopes of protection as would fanciful or arbitrary trademark terms, thereby rendering possible confusion as between Appellant's mark and the cited registered mark as quite unlikely. *See, e.g.*, *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 45 CCPA 856, 254 F.2d 158, 117 USPQ 295, 297 (1958) ("It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owner of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his

mark than would be the case with a strong mark without violating his rights."); *see*, *also*, *Nestles Milk Products, Inc. v. Baker Importing Co.*, 37 CCPA 1066, 182 F.2d 193, 86 USPQ 80 (1950) (the presence of a common element of allegedly conflicting marks that is a word that is "weak" reduces the likelihood of confusion); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 58 CCPA 735, 432 F.2d 1400, 167 USPQ 529 (1970); *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910, 1912 (T.T.A.B. 1988)("[W]e find the term ["IMPERIAL"] to be a relatively weak mark and we agree with applicant that the scope of protection afforded such a mark is considerably narrower than that afforded a more arbitrary designation."); *Loctite Corp. v. Tubbs Cordage Co.*, 175 USPQ 663, 665 (T.T.A.B. 1972) ("The suggestiveness of the term manifestly is the reason why opposer, applicant and others in the hardware field as well as in other fields of endeavor have adopted and used and/or registered this term or a variant thereof as a trademark for their goods. * * * [Third-party evidence] is admissible and competent when considered along with the nature of the term 'LOCTITE' to delineate opposer's rights therein and thereby narrow the scope of protection to be afforded such a mark."); *Knapp-Monarch Co. v. Poloron Products, Inc.*, 134 USPQ 412 (T.T.A.B. 1962) (portion of a mark may be "weak" in the sense that such portion is descriptive, highly suggestive or is in common use by many other sellers in the market). Hence, absent virtually the same mark for highly related and similar goods or services – which is not the case now presented – the narrow scopes of protection to which the respective marks of the cited trademark registration and of the instant trademark application are entitled, no likelihood-of-confusion should be found to exist.

Additionally, the mark of the applied registration does not appear in a common form of depiction, 37 C.F.R. §2.52(b), but, rather in a stylized manner. As the Trademark Trial and Appeal Board has stated in *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1235 (T.T.A.B. 1992):

> ". . . we note again that opposer has a registration of ELANCE in typed capital letters for underwear. This means that opposer's mark is 'unrestricted as to stylization,' and that in deciding the issue of likelihood of confusion, we must consider opposer's mark ELANCE as it would appear in the various common forms of depiction. [citations omitted] To be perfectly clear, we are not suggesting that because an application or registration depicts a word mark in typed capital letter that therefore the word mark must be considered in all possible forms no matter how extensively stylized. Rather, we are simply indicating that when a drawing in an application or registration depicts a word mark in typed capital letters, this Board – in deciding the issue of likelihood of confusion – 'must consider all reasonable manners' in which the word mark could be depicted. *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (T.T.A.B. 1992)"

Thus, the stylized nature of the mark of the cited registration would further reduce any likelihood of any confusion with Appellant's mark.

In view of the weakness of the terms "ARCTIC" and "HEAT," in combination with the stylized manner of the trademark of the applied registration, which includes the composite wording "COOL DOWN AND FIRE UP," it is respectfully submitted that any confusion between the marks of the instant trademark application and that of the applied trademark registration is unlikely and that the §2(d) likelihood-of-confusion refusal-to-register should appropriately be reversed.

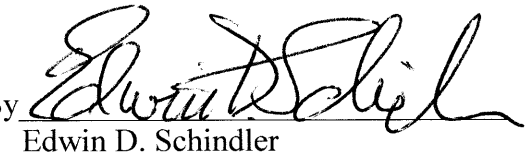
VI. Conclusion

In light of the foregoing, it is respectfully contended that the Examining

Attorney's refusal-to-register under §2(d) of the Trademark Act, pertaining to the Examiner's contention that Appellant's trademark "ARCTIC HEAT" is confusingly similar to the mark of U.S. Trademark Registration No. 2,944,243, should now be reversed by the Trademark Trial and Appeal Board, and the trademark of the instant trademark application should now be passed to publication. Such favorable action is respectfully requested and earnestly solicited.

Respectfully submitted,

POLY GEL, LLC

By 
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January 24, 2011

The Commissioner for Trademarks is hereby authorized to charge the Deposit Account of Applicant's Attorney, Account No. 19-0450, for any fees which may be due in connection with the prosecution of the above-identified trademark application, but which have not otherwise been provided for.